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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,749	05/31/2001	Bijan Tadayon	111325-64	5711

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NIXON PEABODY, LLP
401 9TH STREET, NW
SUITE 900
WASHINGTON, DC 20004-2128

EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT PAPER NUMBER

3621

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,749

Applicant(s)

TADAYON ET AL.

Examiner

Mary Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

1. This action is in response to the amendment filed on June 21, 2004. Claims 1-22 are pending. Claims 1-2, 4-5, 7-8, 10-11, 13, 15-17 and 19 are amended.

Response to Arguments

2. Applicant's arguments filed June 21, 2004 have been fully considered but they are not persuasive.

Regarding to the applicant's newly added limitation the consequential right that linked to another right and exercisable only upon exercise of the another right, Examiner believes that Stefik (U. S. Patent 5,638,443) discloses this matter, in particular at column 22 lines 9-22.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 13-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to the claims 13-15, applicant merely claims functional descriptive material *per se* - "a digital rights management language". According to MPEP 2106 IV B 1 (a), data structures that are not embodied in computer-readable media are not statutory because they are not capable of causing functional change in the computer. See *Warmerdam*, 31 USPQ2d 1754.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Stefik et al., U. S. Patent 5,638,443.

As to claim 1, Stefik teaches a rights management system for managing and enforcing rights to use digital works comprising (column 18 lines 9-22 and Fig. 14):

- a) At least one repository for enforcing rights associated with content (column 6 lines 16-48 and Fig. 1);
- b) one or more consequential rights that are linked to another right associated with content, and are exercisable only upon exercise of the another right (column 18 lines 9-26 and column 22 lines 19-28 and Fig. 14);
- c) a right management module that manages the one or more consequential rights by enforcing use of the content based on the consequential rights, and permitting exercise of the consequential rights only after exercise of the another right to thereby provide sequential access to content in accordance with the another right and the consequential rights (column 18 lines 9-26 and column 22 lines 19-28 and Fig. 14).

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As to claims 2, 8 and 17, Stefik teaches the one or more consequential rights comprise one or more usage rights and one or more consequential values (column 18 lines 9-26 and column 20 lines 63-67 and column 21 lines 31-47 and Fig. 14).

As to claims 3, 9, 14 and 18, Stefik teaches the usage rights comprise copying (column 20 lines 63-67).

As to claims 4, 10 and 19, Stefik teaches the consequential values comprise at least one of an absolute value and a relative value that at least one of allow access or restrict access to one or more digital works (column 21 line 31 – column 22 line 3; *specifically, “an absolute value” corresponds to a fixed and predetermined duration in column 21 lines 37-40, 52-54, 59-61, and “a relative value” corresponds to sliding interval usage duration in column 21 lines 40-42, 62 – column 22 line 3*).

As to claim 5, Stefik teaches the one or more consequential rights are associated with one or more digital works (column 4 lines 15-31 and column 18 lines 9-26 and Fig. 14).

As to claims 6, 12 and 22, Stefik teaches the digital works comprise audio information, multimedia presentations and video information (column 5 lines 48-54).

As to claim 7, Stefik teaches a method of managing and enforcing rights to use digital works in a system having at least one repository for enforcing rights associated with content of the digital work, and the method comprising the steps of (column 6 lines 16-48 and column 18 lines 9-22 and Figs. 1, 14):

- a) electronically determining one or more consequential rights, the consequential rights being linked to another right associated with content and

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being exercisable only upon exercise of the another right (column 18 lines 9-26 and column 22 lines 19-28 and Fig. 14);

b) associating the one or more consequential rights with content (column 4 lines 15-31 and column 18 lines 9-26 and Fig. 14);

c) enforcing use of the content based on the consequential rights, and permitting exercise of the consequential rights only after exercise of the another right to thereby provide sequential access to content in accordance with the another right and the consequential rights (column 18 lines 9-26 and column 22 lines 19-28 and Fig. 14).

As to claim 11, Stefik teaches the one or more consequential rights are associated with one or more portions of information (column 4 lines 15-31 and column 9 line 60 - column 10 line 3 and column 18 lines 9-26 and Figs. 7, 10, 14).

As to claim 13, Stefik teaches a digital rights management language for managing and enforcing rights to use digital works having at least one repository for enforcing rights associated with content of the digital works, the language comprising (column 6 lines 16-48 and column 17 lines 49-61 and column 18 lines 9-22 and Figs. 1, 14):

a) one or more usage rights that define the manner in which content can be used (column 17 lines 49-61 and column 18 lines 9-26 and Fig. 14);

b) one or more consequential rights that are linked to another usage right associated with content, the consequential rights being exercisable only upon

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exercise of the another right (column 17 lines 49-61 and column 18 lines 9-26 and column 22 lines 19-28 and Fig. 14);

c) enforcement instruction that enforces the use of the content based on the consequential rights, and permits exercise of the consequential rights only after exercise of the another usage right to thereby provide sequential access to content in accordance with the another right and the consequential rights (column 18 lines 9-26 and column 22 lines 19-28 and Fig. 14).

As to claim 15, Stefik teaches the consequential rights comprise at least one trigger that at least one of allows access or restricts access to one or more digital works (column 18 lines 19-24 and column 21 line 31 – column 22 line 3).

As to claim 16, Stefik teaches an information storage media with information for managing and enforcing rights to use digital works in a system having at least one repository for enforcing rights associated with content of the digital work, the information storage media comprising (column 6 lines 16-48 and column 18 lines 9-22 and Figs. 1, 14):

- a) information that determines one or more consequential rights, the consequential rights being linked to another right associated with content and being exercisable only upon exercise of the another right (column 18 lines 9-26 and column 22 lines 19-28 and Fig. 14);
- b) information that associates the one or more consequential rights with one or more content (column 4 lines 15-31 and column 18 lines 9-26 and Fig. 14);

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c) information that enforces use of the content based on the consequential rights, and permits exercise of the consequential rights only after exercise of the another right to thereby provide sequential access to content in accordance with the another right and the consequential rights (column 18 lines 9-26 and column 22 lines 19-28 and Fig. 14).

As to claim 20, Stefik teaches the absolute value is at least one of a time and a date (column 21 line 31 – column 22 line 3; *specifically, "the absolute value" corresponds to a fixed and predetermined duration in column 21 lines 37-40, 52-54, 59-61*).

As to claim 21, Stefik teaches the relative value is at least one of based on the status of one or more other usage rights, and one or more events (column 21 line 31 – column 22 line 3; *specifically, "the relative value" corresponds to sliding interval usage duration in column 21 lines 40-42, 62 – column 22 line 3*).

Conclusion

7. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

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8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The article titled "Authentica Announces PageRecall for Sun Solaris; First Active Rights Management Solution for Sun Solaris that Lets Users Dynamically Control the Use of Sensitive Digital Information" (Business Wire, February 20, 2001) discloses delivering unprecedented electronic document security and rights management capabilities to Sun Solaris users.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 10:00 AM to 7:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

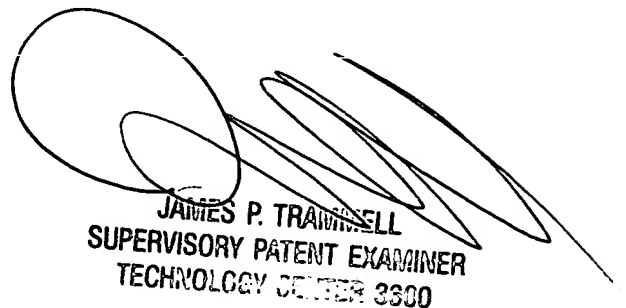
The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306 (Official Communications; including After Final
Communications labeled "BOX AF")

(703) 746-5619 (Draft Communications)

Hand delivered responses should be brought to Crystal Plaza Two, Room 1B03.

Mary Cheung
Patent Examiner
Art Unit 3621
September 17, 2004


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600